Paper No. 15

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte STEPHEN R. MOYSAN, III AND ROLIN W. SUGG

Appeal No. 95-2249
Application 08/013,916[1]

ON BRIEF

Before LYDDANE, GARRIS, and McQUADE, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 14, 15, 19 and 24 through 26, which are all of the claims remaining in the application.

The subject matter on appeal is directed to an article comprising a metallic substrate having on at least a portion of

1 Application for patent filed February 5, 1993.

its surface a multi-layered brass colored coating and to an article comprised of brass having a protective and decorative multi-layer coating simulating brass. Claims 14 and 24 are exemplary of the invention and read as follows:

14. An article comprising a metallic substrate having disposed on at least a portion of its surface a multi-layer brass colored coating consisting essentially of:

layer comprised of semi-bright nickel on said substrate;

layer comprised of bright nickel on said layer comprised of semi-bright nickel;

layer comprised of palladium-nickel alloy on said layer comprised of nickel;

layer comprised of zirconium on said layer comprised of palladium alloy; and

top layer comprised of zirconium compound on said layer comprised of zirconium.

24. An article comprised of brass having deposited on at least a portion of its surface a protective and decorative multi-layer coating simulating brass consisting essentially of:

first layer comprised of semi-bright nickel;

second layer comprised of bright nickel;

third layer comprised of palladium-nickel alloy;

fourth layer comprised of zirconium; and

top layer comprised of zirconium nitride.

The references of record relied upon by the examiner in rejections of the claims under 35 U.S.C. § 103 are:

Kishi et al. (Kishi)	4,699,850	Oct. 13, 1987
Naik	4,761,346	Aug. 2, 1988
Hanai (Japanese Kokai)[2]	56-166,063	Dec. 19, 1981

Lowenheim, F. A., "Decorative/Protective Coatings: Copper, Nickel, Chromium", Electroplating, pp 210-225 (1978).

Claims 14, 15, 19 and 24 through 26 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending application Serial No. 08/013,913.

Claims 14, 15, 19 and 24 through 26 stand rejected under 35 U.S.C. 103 as being unpatentable over Hanai[3] in view of Lowenheim, Naik and Kishi; or alternatively, unpatentable over Kishi in view of Lowenheim, Naik and Hanai.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellants, we refer to pages 3 through 19 of the examiner's answer and to pages 4 through 17 of the

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2 Our understanding of this reference results from our reading of the translation of this reference which was supplied by the appellants and is of record in the application file.

3 We have chosen to use the U.S. PTO convention of identifying the Japanese '063 reference by the last name of the first named inventor.

appellants' brief, filed March 14, 1994[4] for the full exposition thereof.

OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art, and to the respective positions advanced by the appellants and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to all claims on appeal. However, the examiner's provisional rejection based on the judicially created doctrine of obviousness type double patenting is sustained. Our reasoning for this determination follows.

Considering first the provisional rejection of claims 14, 15, 19 and 24 through 26 under the judicially created doctrine of obviousness-type double patenting, appellants have not disputed the propriety of this rejection but have acquiesced thereto by the statement that "[a]ppellants stand ready to file a Terminal

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4 We note that the brief filed August 15, 1994, as noted by the examiner in the letter dated October 26, 1994, Paper No. 14, apparently was filed merely to provide a correct copy of the claims on appeal in the appendix thereto.

Disclaimer upon allowance of claims in the applications" on page 4 of the brief. Therefore, we shall summarily sustain the examiner's rejection on this ground.

However, we reach an opposite conclusion with respect to the examiner's alternative rejections of claims 14, 15, 19 and 24 through 26 under 35 U.S.C. § 103 over Hanai in view of Lowenheim, Naik and Kishi or Kishi in view of Lowenheim, Naik and Hanai for substantially the reasons set forth by appellants in the brief. We recognize that Hanai discloses a multi-layer plated metallic article having a brass or German silver substrate coated with a nickel alloy layer, onto which is coated a palladium alloy layer, onto which is plated a titanium nitride layer. Also, as noted in "Experiment 2," the titanium nitride coat can be plated over with a gold coat. We also recognize that Kishi discloses a multi-layer plated metallic article having a metal substrate (e.g., brass) having a nickel plated layer, a nickel-palladium alloy layer, a gold colored titanium nitride layer, a gold colored zirconium nitride layer, and a gold alloy coating (note Example 3 in columns 3 and 4 of Kishi). Moreover, it is also clear that the Lowenheim discloses a "duplex" nickel system and that Naik discloses a layered erosion resistant coating for a metallic substrate that includes a first layer of palladium or nickel, a

second layer of titanium or zirconium and a third layer of titanium nitride or zirconium nitride. However, we find nothing in the applied prior art, or from knowledge clearly present in the prior art, to suggest the modifications to Hanai or Kishi proposed by the examiner in the alternative rejections of the claims on appeal under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)(quoting In re Rinehart, 531 F.2d 1048, 1051-52, 189 USPQ 143, 147 (CCPA 1976)). A rejection based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the

invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178(CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has also repeatedly cautioned against employing hindsight by using the appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). That court has also cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as § 103 requires. See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). Like the appellants, we think that the examiner has relied here on impermissible hindsight to provide the missing motivation to combined the teachings of the applied references.

As stated in W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 861 (1984),

> [t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our conclusion that the only reason to combine the teachings of the applied references in the manner proposed by the examiner results from a review of appellants' disclosure and the application of impermissible hindsight. Thus, we cannot sustain either of the examiner's alternative rejections of appealed claims 14, 15, 19, and 24 through 26 under 35 U.S.C. § 103.

Accordingly, the decision of the examiner rejecting claims 14, 15, 19 and 24 through 26 under the judicially created doctrine of obviousness-type double patenting is affirmed, but the decision rejecting claims 14, 15, 19 and 24 through 26 under 35 U.S.C. § 103 is reversed. Since at least one rejection of all the claims on appeal has been affirmed, the examiner's decision is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

WILLIAM E. LYDDANE)
Administrative Patent Judge)
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)
BRADLEY R. GARRIS) BOARD OF PATENT
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